

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 1, 8, 10, 12, 13, 22, and 23 have been amended. Claims 1-4 and 6-23 are pending and under consideration.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

The Applicant requests entry of this Rule 116 Response because:

it is believed that the amendment of claims 1, 8, 12, 22, and 23 puts this application into condition for allowance; the amendment of claims 1 and 22 should not entail any further search by the Examiner since no new features are being added; and the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised. Claims 10 and 13 were allowed on page 4 of the Office Action dated December 15, 2005. Claims 10 and 13 are currently amended to correct grammatical errors. No new matter is being added.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. §102:

Claims 1-3, 5-9, 11, 12, 14, 15 and 17-23 are rejected under 35 U.S.C. §102(b) as being anticipated by Sann (U.S. Patent No. 5,968,574). On page 2 of the Office Action, the Examiner merely repeats his rejection that was found on page 2 of the previous Office Action issued on September 9, 2005. On page 4, item 7 of the Office Action mailed December 15, 2005, the Examiner asserts that "in response to [the] Applicant's argument that the references fail to show certain features of [the] Applicant's invention, it is noted that the feature upon which [the] Applicant relies are not recited in the rejected claims." The Applicant respectfully disagrees.

Amended claim 1 recites, "A steam oven, comprising: a steam generator inside the steam oven; a cooking cavity; a steam feed pipe to feed steam generated by the steam

generator into the cooking cavity; a steam distributing pipe disposed at an end of the steam feed pipe to distribute the steam from the steam feed pipe into the cooking cavity; and a sectional area control part, directing the steam from the steam generator into the cooking cavity, and increasing a flow speed of the steam.”

Claim 8 recites “an apparatus, comprising: a cooking cavity; a steam generator generating steam; and a sectional area control part, directing the steam from the steam generator into the cooking cavity, and increasing a flow speed of the steam.”

Amended claim 22 recites “a steam oven, comprising: a cooking cavity; a steam generator inside the steam oven generating steam; a steam feed pipe directing the steam from the steam generator; a sectional area control part, disposed in the steam feed pipe and increasing a flow speed of the steam; at least one steam distributing pipe, directing the steam from the steam feed pipe into the cooking cavity and further increasing the flow speed of the steam; and an end wall positioned adjacent to the sectional area control part at an end of the steam feed pipe opposite to the steam generator, connected to a first end of the at least one steam distributing pipe, and directing the steam from into the at least one steam distributing pipe.”

Amended claim 23 recites “a steam oven, comprising: a cabinet; a steam generator which is installed in the cabinet.”

The teachings of Sann would not apply to the present invention because Sann is related to a steam oven with a steam generator 78, 80, 82 that is outside of the steam oven (fig. 1). Sann shows a steam oven with a steam generator 78, 80, 82 that is outside of the steam oven (FIG. 1). Sann teaches away from the present invention in the following passages:

col. 2, lines 58-62:

The steam is generated by a steam boiler remotely located, preferably in a basement, utility room or other area outside of the food preparation area or kitchen and the steam generated by the boiler is delivered to the food steaming chamber by a feed pipe.

col. 5, line 54 – col. 6, line 6:

Steam is supplied to the steaming chambers 12 via the feed pipe 54 preferably by a remotely located steam boiler 78. The steam boiler 78 receives heated water from a hot water heater 80 which receives water from a standard water supply or other source 82. The steam is preferably delivered to the steam chambers 12 at a temperature between 210° F. and 215° F. for quick, efficient and complete cooking, thawing, defrosting and/or steaming of the food

within the chambers 12. Preferably a pressure switch 84 or other regulating device is provided in line on the feed pipe 54 from the steam boiler 78 to the steam pipe 50.

Referring to FIG. 9, the remote location of the steam boiler 78 and the water heater 80 is diagrammatically shown relative to the steaming chambers 12. Moreover, multiple steaming chambers 12 are supplied with steam by the steam boiler 78 which may be in a basement, utility room or other area and multiple steaming chambers 12 may be remotely located relative to each other, for example, in a kitchen of an establishment and a separate bar service area as shown in FIG. 9.

The present invention is directed to a steam generator 20 that is in the inner surface of the lower wall of the cabinet (FIG. 1 & 2). The steam generator 20 is inside of the steam oven. Paragraph 31 states: because the flow speed of the steam increases twice, because of the sectional area control part 24 and the steam distributing pipes 22, the steam oven more effectively generates the turbulent flow of steam, so that the steam oven more effectively feeds the steam from the steam generator 20 into the cooking cavity 11 without an additional blowing unit. Amended claims 1 and 22 recite "a steam generator inside the steam oven." Claim 8 is directed to an apparatus that inherently includes a steam generator inside the apparatus. Therefore, the steam in the present invention is evenly distributed into all areas of the cooking cavity.

On page 4 in item 7b, the Examiner asserts that the solenoid valve 56 controls the flow of steam. On the contrary, claim 1 recites "...a sectional area control part, directing the steam from the steam generator into the cooking cavity, and increasing a flow speed of the steam (*emphasis added*).". Sann does not teach or suggest increasing a flow speed of the steam. Sann discusses a solenoid valve 56 or similar device which can open or close to permit or prevent, respectively, the flow of steam from the feed pipe 54 to the steam pipes 50 within the chamber 12 (col. 5, lines 20-25). The present invention is directed to increasing a flow speed of the steam. Sann fails to teach or suggest a sectional area control part to increase a flow speed of the steam in the steam feed pipe. Therefore, Sann does not teach or suggest claims 1-3, 5-9, 11, 12, 14, 15 and 17-23.

REJECTION UNDER 35 U.S.C. §103:

Claim 16 is rejected under 35 U.S.C. §103 (a) as being unpatentable over Sann. It is respectfully submitted that the outstanding Office Action's rejection of claim 16 fail to set forth a prima facie obviousness case.

In particular, as noted in the Applicant's previous response, regarding the proffered teaching of Sann, to include the claimed steam distributing pipe is pressed stainless steel, it is respectfully submitted that the outstanding Office Action has failed to address the Applicant's particular non-obviousness remarks. The Examiner also failed to address the amendment to claim 16.

Previously, the Applicant particularly discussed Sann, the underlying rationale/desires for features in each reference, and the lack of motivation for the proffered modification based on the same. The Office Action has apparently merely repeated the previous obvious rationale and issued a boilerplate PTO obviousness response "accordingly, it would have been obvious..." followed by the Examiner's own conclusion (not supported in the record) "to have utilized any process including that which is recited in the claims to have produced the distributing pipe by pressing stainless steel."

However, it is respectfully submitted that the Office Action's PTO boilerplate obviousness response and continued reliance on rationale unsupported by the record is insufficient to meet the requirements under MPEP 707.07(f), where the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the Applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

As such, since the Examiner has not addressed the applicant's traversals presented in the Amendment filed October 31, 2005, it is respectfully requested that the Examiner issue a new non-final Office Action addressing the Amendment of October 31, 2005.

IMPROPER OBVIOUSNESS RATIONALE

As noted above, the rejection rationale presented in the outstanding Office Action has set forth the rationale that "it would have been obvious to one of ordinary skill in the art at the time of

the invention to have utilized any process including that which is recited in the claims to have produced the distributing pipe by pressing steel."

Thus, the Office Action is setting forth a motivational rationale not supported by the record, but rather based solely on the Examiner's belief of what one skilled in the art may have tried or recognized.

However, to set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper."

The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

In *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984), "the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Sann* does not provide any motivation or reason why one would make the necessary changes in

the reference device.

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of **"common knowledge" and "common sense"** may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Contrary to these requirements, the outstanding Office Action merely presents the proposal that Sann includes the claimed steam distributing pipe is "produced by pressing stainless steel" although claim 16 recites "pressed stainless steel," which the Office Action has interpreted as being disclosed in Sann, and concludes the obviousness of the same, without providing support in the record for motivation of the same.

Such motivational conclusions are improper. The relied upon motivation must be evidenced in the record, and cannot be based merely on an opinion of the Examiner.

Accordingly, it is respectfully requested that the next Office Action following the above guidelines and present a new non-final Office Action, if necessary, presenting rejections based on the same.

ALLOWABLE SUBJECT MATTER:

Claims 4, 10, and 13 are allowed.

CONCLUSION

In accordance with the foregoing, the Applicant respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which

action is earnestly solicited. At a minimum, the Board should enter this Amendment at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration.


If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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